

Application No.: 09/733,773

Attorney Docket No.: SALK2410

Filing Date: December 8, 2000

(088802-5651)

Response to Office Action (mailed April 7, 2005) faxed September 2, 2005

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Remarks

Courtesies extended to Applicants' representative at the personal interview held June 23, 2005, and in follow-up telephone discussions on August 8 and 9, 2005, are acknowledged with appreciation.

As discussed at the personal interview, in accordance with the present invention, there are provided the crystal structure and atomic coordinates of a Pin1 WW domain co-complexed with a Pin1 WW domain binding agent. The invention provides methods of identifying Pin1 WW domain binding agents employing such crystal structure and atomic coordinates. The invention further provides computer programs for use in developing Pin1 WW domain binding agents.

By the present communication, claims 1, 7, 10 and 18 have been amended to define Applicants' invention with greater particularity. These amendments add no new matter as they are fully supported by the specification and original claims. To summarize, the amendments provided herewith:

- (1) incorporate the language from claim 10 (which has been indicated to be allowable) into independent claims 1 and 18,
- (2) re-write claim 7 (which has been indicated to be allowable) in independent form, and add claims 30 and 31 dependent therefrom (repeating the requirements of original claims 9 and 11),
- (3) introduce new claim 29 (representing the combination of original claim 18, plus the requirements of claim 7),
- (4) add a "wherein" clause to each of the independent method claims (pursuant to an issue raised for the first time at the personal interview—providing a further description of the "identifying" contemplated by the claimed method), and
- (5) in an effort to reduce the issues and expedite prosecution, and not in response to any issues currently on the record, cancel claims 12 and 32 without prejudice.

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It is respectfully submitted that the amendments provided herewith place the present application in condition for allowance, or at a minimum, in better condition for appeal. Accordingly, entry of the amendments submitted herewith is respectfully requested.

Upon entry of the amendments submitted herewith, claims 1, 3-11, 18 and 29-31 will be pending and under active consideration. The present status of all claims in the application is provided in the Listing of Claims presented herein beginning on page 2.

The Rejection under 35 U.S.C. § 103(a)

The rejection of claims 1-6, 8, 9, 11, 12 and 18 under 35 U.S.C. § 103(a), as allegedly being unpatentable over Ranganathan *et al.* (*Cell* 89:875-886, 1997), in view of Lu *et al.* (U.S. Patent No. 6,495,376), in further view of Klebe (*J. Mol. Med.* 78:269-281, 2000), is once again respectfully traversed for at least the reasons of record. As discussed in detail in Applicants' prior submissions, Applicants respectfully submit that none of these references, either taken alone or in combination, teaches or suggests the methods of the present invention.

However, as discussed at the personal interview, in order to reduce the issues and expedite prosecution, claim 1, as amended herein, incorporates the requirements of original claim 10 (which has been acknowledged to be allowable). Similarly, the only other independent claim in the case, i.e., claim 18, has also been amended herein to incorporate the requirements of original claim 10.

Furthermore, claim 7, also acknowledged to be allowable, has been re-written in independent form (and new claims 30 and 31, dependent thereon, have been introduced). Similarly, new claim 29 is also presented—representing the combination of original claim 18, plus the requirements of claim 7.

It is respectfully submitted that the rejection under 35 U.S.C. § 103(a) is not applicable to the claims as amended herein. Moreover, it is respectfully submitted that this rejection is not applicable to new claims 29-31.

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Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a).

Conclusion

In view of the above amendments and remarks, reconsideration and favorable action on all claims are respectfully requested. In the event any matters remain to be resolved in view of this communication, the Examiner is encouraged to call the undersigned so that a prompt disposition of this application can be achieved.

Respectfully submitted,

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By



FOLEY & LARDNER LLP

Customer Number: 30542

Telephone: (858) 847-6711

Facsimile: (858) 792-6773

Stephen E. Reiter

Attorney for Applicant

Registration No. 31,192